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EXAMINER	
LETT, THOMAS J	
ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,454	WATANABE ET AL.	
	Examiner	Art Unit	
	Thomas J. Lett	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14-18 and 20-27* is/are rejected.

7)☒ Claim(s) *13 and 19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 April 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because the term "Document registering apricution" should be changed to read "Document registering application" in Figure 3.

2. The drawings are objected to because the phrase "Cellular phone mail address" should be changed to read "User mail address" or "Recipient mail address" in Fig. 6, Fig. 8 (ST808, ST813), and Fig. 9 (ST904).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because Applicant uses the phrase "email address of a cellular phone". Email addresses are associated with a user. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: the phrase "email address of a cellular phone". There are several occurrences of the phrase and the phrase should be similar to that used in paragraph 27, line 5, which reads "electronic mail for a user".

Appropriate correction is required.

Claim Objections

5. Claim 6 is objected to because of the following informalities: the term "and" should be inserted between the terms "printed," and "a selection" on p.33, line 7. Appropriate correction is required.

6. Claim 11 is objected to because of the following informalities: the phrase "that stores an output device of a print destination" should be changed to read "that stores a print destination of an output device". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 3, 23, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims an "email address of a

cellular phone". An 'email address' is a string that identifies a user and is associated with a user or recipient having an account on a mail server. An "Inbox" associated with an email address of a user can be checked at any device (e.g., computer, PDA, mobile phone) capable of connecting with a mail server.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10, 14-18, and 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al (USPN 6,430,601 B1).

With respect to claim 1, Eldridge et al disclose a document transmission apparatus (token-enabled server 126, see Fig. 2) comprising:

a print document manager (token-aware shared document server 134) that stores a document (documents stored on server 134, col. 4, lines 42-43) to be printed in association with an e-mail address of a cellular phone (any mobile computing device 118 can communicate with the token-aware document server 134, col. 4, lines 46-48);

a mail transmitter (token-aware notification server 143 sends paging messages to mobile device 118, col. 8, lines 7-9) that transmits, when the document to be printed is stored in the print document manager, a print notification message to the e-mail address of the cellular phone, the print notification message indicating that the document to be printed exists;

a print instruction acquirer (token-enabled server 126, col. 8, lines 25-30) that acquires print instruction information from the cellular phone (receives a request for reproduction of a document from a mobile computing device 118, col. 8, lines 26-30) that receives the print notification message; and

a document transmitter (token-enabled server 126, col. 8, lines 25-30) that transmits the document to be printed to a print destination (to printer 102, col. 8, line 30) designated in accordance with the print instruction information acquired by the print instruction acquirer.

With respect to claim 2, Eldridge et al disclose the print instruction acquirer (token-enabled server 126) transmits an instruction screen that includes an input screen to be displayed on the cellular phone (the user selects a document token from "Inbox" folder 520, which is accessible from the start menu screen 518 shown in FIG. 5, col. 9, lines 44-47) that is programmed so as to return the print instruction information input on the input screen and acquires the print instruction information returned by using the instruction screen (the token-enabled server 126 recovers the document related to the Inbox token and directs it to a selected printer, col. 9, lines 26-30)

With respect to claim 3, Eldridge et al disclose a user manager (Notification LUT 145 that stores Pager IDs which are addresses of mobile communication devices, col.

7, lines 9-15) that stores the e-mail address of the cellular phone in association with a predetermined electronic mail address; and

a print document registering unit (File Watcher Process 158) that registers, when the predetermined electronic mail address receives an electronic mail having an attachment file, the attachment file as the document to be printed to the print document manager (the file watcher process 158 registers with the file server 104 to receive notification of file or directory events of files monitored in file space 202, col. 7, lines 65-66).

With respect to claim 4, Eldridge et al disclose a print document registering unit (File Watcher Process 158) that registers a document transmitted from a client computer connected via network as the print document to be printed to the print document manager (the file watcher process 158 registers with the file server 104 to receive notification of file or directory events of files monitored in file space 202, col. 7, lines 65-66).

With respect to claim 5, Eldridge et al disclose that the print notification message (document token) includes a URL corresponding to the document transmission apparatus (a document token is a document URL which consists of three fields: a protocol field, a field with the DNS (Domain Name System) name of a host system, and a file name field).

With respect to claim 6, Eldridge et al disclose that the instruction screen includes a list of documents (see mobile computing device's display screen in Fig. 6)

With respect to claim 7, Eldridge et al disclose that when print document information selected from the list of print documents is received, the print instruction

acquirer transmits a detail screen that displays text data (the data can be textual data, graphics data, audio data, video data, or image data, col. 7, lines 31-35 and see Fig. 10) extracted from the document to be printed in accordance with the received print document information (receives a request for reproduction of a document from a mobile computing device 118, col. 8, lines 26-30).

With respect to claim 8, Eldridge et al disclose that the selection key (SERVICES key in Fig. 6) includes a FAX key to display a screen to input a telephone number of a facsimile apparatus of a print destination where the document to be printed is printed (the transaction server 144 is adapted to manage transaction requests from mobile computing devices 118 that involve requests for document services available on networks 116 (which includes fax server 106) and 122, col. 4, lines 27-30).

With respect to claim 9, Eldridge et al disclose that the selection key (SERVICES key in Fig. 6) includes a print destination designation key (the transaction server 144 is adapted to manage transaction requests from mobile computing devices 118 that involve requests for document services available on networks 116 in conjunction with a directory server 142 maintaining a database of token-enabled devices (e.g., printer 102 and scanner 110), col. 4, lines 27-32) to display a list of print destinations that are capable of printing the document to be printed (see Fig. 8 for folders that list "Print Services" by different locations).

With respect to claim 10, Eldridge et al disclose that the print instruction acquirer transmits an acceptance result, indicating contents of the print instruction information, to the cellular phone in accordance with the input print instruction information input through the instruction screen at the cellular phone (Figs. 5-8 both show a "STATUS" indicator

516 for providing feedback to the user on the display 500 of the mobile computing device 118).

With respect to claim 14, Eldridge et al disclose a cellular phone apparatus (mobile computing device 118) comprising:

a reception system (mobile computing device 118) that receives a print notification message (token) indicating presence of a document to be printed from a document transmission apparatus (tokens represent documents stored on a token-aware shared document server 134, col. 4, lines 42-48) ;

a transmitting system (SERVICES key in Fig. 6) that transmits a request for a print instruction screen to the document transmission apparatus, when a URL (a token is a superset of a URL, col. 4, lines 59-62) described in the print notification message is selected (using selector 508) (mobile computing device 118 transmits requests to the transaction server 144 that involve requests for document services available on networks 116 which includes Internet 122, col. 4, lines 27-30);

a display (see any of Figs. 5-10) that displays the print instruction screen that is received in response to the request;

a system that transmits print instruction information to the document transmission apparatus when the print instruction information is input through the print instruction screen (mobile computing devices 118 transmit requests to the transaction server 144 that involve requests for document services available on networks 116 which includes Internet 122, col. 4, lines 27-30).

With respect to claim 15, Eldridge et al disclose that the print instruction screen includes a list of print documents (Fig. 6 shows a list of documents that can be printed

or handled using the 'SERVICES' button 702) and a selection key ('SERVICES' button 702) to instruct to display a screen to designate a print destination that prints the document to be printed (mobile computing device 118 transmits requests to the transaction server 144 that involve requests for document services available on networks 116 which includes Internet 122, col. 4, lines 27-30).

With respect to claim 16, Eldridge et al disclose that when a document to be printed is selected from the list of print documents, a detail display of the document to be printed is displayed (a display showing more details of a document is shown in Fig. 7).

With respect to claim 17, Eldridge et al disclose a document transmission apparatus (using personal workstation 108 with token-enabled server 126) comprising:

a URL input screen transmitter (personal workstation 108) that transmits a screen to input a URL (a token or URL can be transmitted to device 118 to indicate a document such as a webpage on the Internet 122) to a predetermined cellular phone (device 118) in response to a request from the predetermined cellular phone;

a home page information acquirer that receives a URL information from the predetermined cellular phone and accesses a webserver corresponding to the URL information to obtain a home page information (mobile computing device 118 transmits requests to the transaction server 144 that involve requests for document services available on networks 116 which includes Internet 122, col. 4, lines 27-30);

a print instruction acquirer (token-enabled server 126 via transaction server 144) that acquires print instruction information from the predetermined cellular phone; and

a document transmitter (transaction server 144) that transmits the home page information to a designated print destination in accordance with the print instruction information acquired by the print instruction acquirer (mobile computing devices 118 transmit requests to the transaction server 144 that involve requests for document services available on networks 116 which includes Internet 122, col. 4, lines 27-30).

With respect to claim 18, Eldridge et al disclose a document transmission apparatus according to claim 17, wherein the print instruction acquirer (token-enabled server 126) transmits an instruction screen (see information transmitted to mobile device 118 in Figs. 5-10) that includes an input screen to be displayed on the predetermined cellular phone and that is programmed so as to return the print instruction information input on the input screen, and further the print instruction acquirer acquires the print instruction information returned by using the instruction screen (using selector 508 with 'SERVICES' 702 or 'PRINT' 802 to transmit requests to the transaction server 144, col. 4, lines 27-30).

With respect to claim 20, Eldridge et al disclose a cellular phone apparatus comprising:

a transmitting system that transmits a request for a URL input screen (mobile computing devices 118 transmit requests, col. 4, lines 27-30; and document tokens (URL supersets) may reference documents on any standard web server operating on Intranet 116 or Internet 122, col. 4, lines 62-64) to a document transmission apparatus and that transmits a request for a print instruction screen to the document transmission apparatus after a URL is input to the URL input screen that is received in response to the request for the URL input screen; and

a display that displays the print instruction screen that is received in response to the request for the print instruction screen (see information transmitted to mobile device 118 in Figs. 5-10);

the transmitting system (mobile computing device 118) further transmitting print instruction information to the document transmission apparatus when the print instruction information is input through the print instruction screen (using selector 508 with 'SERVICES' 702 or 'PRINT' 802 to transmit requests to the transaction server 144, col. 4, lines 27-30).

With respect to claim 21, Eldridge et al disclose a cellular phone apparatus (mobile computing device 118) according to claim 20, wherein the print instruction screen (Figs. 5-10) includes at least a portion (token) of the homepage information corresponding to the URL input from the URL input screen and a selection key to instruct to display a screen to designate a print destination that prints the homepage information (mobile computing devices 118 transmit requests, col. 4, lines 27-30; and document tokens (URL supersets) may reference documents on any standard web server operating on Intranet 116 or Internet 122, col. 4, lines 62-64).

With respect to claim 22, Eldridge et al disclose a cellular phone apparatus (mobile computing device 118) that displays a print instruction screen to instruct for a predetermined print destination to print, and that instructs for the predetermined print destination to print in accordance with print instruction information input through the print instruction screen (using selector 508 with 'SERVICES' 702 or 'PRINT' 802 to transmit requests to the transaction server 144, col. 4, lines 27-30).

With respect to claim 23, Eldridge et al disclose a document transmission method, comprising:

storing a print document (documents are stored on server 134) in association with an e-mail address (Notification LUT 145 that stores Pager IDs which are addresses of mobile communication devices, col. 7, lines 9-15) of a cellular phone into a print document manager (token-aware shared document server 134);

transmitting a print notification message to the e-mail address of the cellular phone (token-aware notification server 143 sends paging messages to mobile device 118, col. 8, lines 7-9), when the print document is stored in the print document manager, the print notification message indicating that the print document is present;

obtaining print instruction information from the cellular phone that receives the print notification message (mobile computing devices 118 transmit requests to the transaction server 144 that involve requests for document services available on networks 116 which includes Internet 122, col. 4, lines 27-30); and

transmitting the print document to a print destination (to printer 102, col. 8, line 30) designated in accordance with the print instruction information.

With respect to claim 24, Eldridge et al disclose a document transmission method according to claim 23, further comprising:

transmitting an instruction screen (a token sent to any of mobile device displays of Figs. 5-10 that can be selected using selector 508 and either SERVICES 702 or PRINT 802) that includes an input screen to be displayed on the cellular phone and that is programmed so as to return the print instruction information input on the input screen, and wherein the obtaining obtains the print instruction information returned by using the instruction screen.

With respect to claim 25, Eldridge et al disclose a document transmission method (see Fig. 7) according to claim 23, wherein the print document ("SALES FIGURES.DOC") is an attachment file attached to an electronic mail (email from JOE@XEROX.COM) received at a predetermined electronic mail address (sent to "InBox 520 in Fig. 5) relating to the e-mail address of the cellular phone (mobile computing device 118).

With respect to claim 26, Eldridge et al disclose a document transmission method, comprising:

transmitting a screen to input a URL to a cellular phone in response to a request from the cellular phone (mobile computing devices 118 transmit requests, col. 4, lines 27-30; and document tokens (URL supersets) may reference documents on any standard web server operating on Intranet 116 or Internet 122, col. 4, lines 62-64);

receiving URL information (token sent to server 126) from the cellular phone (mobile computing device 118);

accessing a webserver having the URL information in accordance with the URL information received from the cellular phone to get homepage information (document tokens (URL supersets) may reference documents on any standard web server operating on Intranet 116 or Internet 122, col. 4, lines 62-64);

obtaining print instruction information from the cellular phone (mobile computing device 118) using selector 508 with 'SERVICES' 702 or 'PRINT' 802 to transmit requests to the transaction server 144, col. 4, lines 27-30).;

transmitting the homepage information to a designated print destination in accordance with the print instruction information received from the cellular phone (using selector 508 with 'SERVICES' 702 or 'PRINT' 802 to transmit requests to the transaction server 144, col. 4, lines 27-30).

With respect to claim 27, Eldridge et al disclose a document transmission method according to claim 26, further comprising:

transmitting an instruction screen (token) that includes an input screen to be displayed on the cellular phone (a token sent to any of mobile device displays of Figs. 5-10 that can be selected using selector 508 and either SERVICES 702 or PRINT 802) and

that is programmed (once selected using command buttons of display 500) to return the print instruction information input on the input screen, and wherein the obtaining obtains the print instruction information returned by using the instruction screen (the transaction server 144 will manage transaction requests from mobile computing devices 118 that involve requests for document services available on networks 116, col. 4, lines 27-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (USPN 6,430,601 B1) in view of Singhal (USPN 6,256,666 B1).

With respect to claim 11, Eldridge et al disclose a management table (a "Network Neighborhood" is shown in Fig. 5) that stores an output device of a print destination (a network neighborhood stores a list computers, printers and other resources connected to the network) that prints the document to be printed in association with a printing method of the output device. Eldridge et al does not disclose a print data generating unit that generates print data appropriate for the printing method of the output device of the print destination designated in the print instruction information acquired from the cellular phone. Singhal discloses a printer 16 as well as a displayed Attachment Control

Message in Fig. 4 which shows a document list that can list selected printer (401), facsimile (402), and/or file destination parameters (fax # "919-555-9453) for each document ("oak"), that can be used in conjunction with a viewer application to control output). Eldridge et al and Singhal are analogous art because they are from the similar problem solving area of remote document management. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the displayed feature of Singhal to Eldridge et al in order to obtain a document table with details of documents to be printed. The motivation for doing so would be to display management of documents.

With respect to claim 12, Eldridge et al do not disclose that the document transmitter determines communication protocol based upon the printer type and the printer address of the print destination designated in the print instruction information acquired from the cellular phone, and transmits the print data to the indicated print destination by using the determined communication protocol. Singhal discloses that the document transmitter (MMP 550) determines communication protocol based upon the printer type and the printer address of the print destination designated in the print instruction information acquired from the cellular phone, and transmits the print data to the indicated print destination by using the determined communication protocol (Examiner notes that it is obvious that the software syntax of the MMP 550 would choose the proper protocol to transmit the documents to either a facsimile device, a network printer, or a storage network location). Eldridge et al and Singhal are analogous art because they are from the similar problem solving area of remote document management. At the time of the invention, it would have been obvious to a

person of ordinary skill in the art to add the delivery determining feature of the MMP 550 of Singhal to Eldridge et al in order to obtain a delivery apparatus capable of selecting appropriate transmission to a device. The motivation for doing so would be to correctly route documents.

Allowable Subject Matter

10. Claims 13 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kumar et al (USPN 6,240,445 B1) discloses a system of a received message (e.g., a facsimile message) by sending a notification message to a user, e.g., using e-mail as well as notifications that comprise URLs.

Lamming et al (USPN 5,862,321 A) discloses a system and method that allows peripheral devices to receive, transmit and store document references or tokens, each of which is associated with an electronic document stored in a database.

Osumi (JP 07212395 A) discloses a facsimile server that notifies a user of an incoming fax by email notification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:
Crystal Park II
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TJL

KA Williams

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER